

Remarks

Claims 1, 2, 5, 6, 7 and 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 1,877,820 to Costello. Claims 3 and 4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Costello in view of U.S. Patent 6,334,817 to Ezawa et al. Claims 8 and 9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Costello in view of Gentiluomo and Nesbitt. Claims 11-13 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Costello in view of Kibamoto. Claims 14-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Costello in view of Hull. Lastly, Claims 1-17 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Regarding the latter, the phrase “officially-sized” used throughout the claims to describe parameters of the golf ball have been removed by amendment. Therefore, withdrawal of the 35 U.S.C. 112 rejections is respectfully requested.

The present invention is a golf swing training apparatus for teaching a proper golf swing for hitting a ball having a given diameter. In particular, the present invention provides an elongated shaft having a lower end and an upper end, the upper end including a hand grip; and a club head attached to the lower shaft end, the club head having a ball striking face, a backside face and a ball-capturing cavity within the club head, the cavity opening to a circular ball-receiving aperture centered on the ball-striking face, wherein the circular ball-receiving aperture has a diameter slightly larger than the given diameter of the ball, and wherein the

Appl. No. 10/686,125
Amdt. dated February 4, 2005
Reply to Office action of September 20, 2004

ball-capturing cavity is decreasingly tapered such that ball entering the ball-receiving aperture as a result of a proper golf swing will be lodged within the ball-capturing cavity.

The present invention provides that the club mimics a standard golf club, and the circular ball-receiving cavity is placed on the center of the ball striking face of the club in order to promote a swing that allows for the club face to strike the ball in the proper orientation.

The Present Invention Is Novel Over U.S. Patent 1,877,820 to Costello

As stated in MPEP §2131, a claim is anticipated under §102 only if each and every element as set forth in the claim, in as complete of detail, is found in a single prior art reference. The claimed invention, according to independent claims 1 and 17, as currently amended, include a recitation for a tapered ball-capturing cavity within the club head, the cavity opening to a circular ball-receiving aperture centered on the ball-striking face, wherein the circular ball receiving aperture has a diameter slightly larger than the given diameter of the ball. As such, for a cited reference to be anticipatory, the reference must describe this identical element. In other words, the reference, to teach in as much detail as is claimed by the present invention, must disclose a tapered ball-capturing cavity within the club head, the cavity opening to a circular ball-receiving aperture centered on the ball-striking face, wherein the ball receiving aperture has a diameter slightly larger than the given diameter of the ball.

Costello does not teach the ball-capturing structure required by claims 1 and 17 of the present application because Costello does not teach a circular ball receiving aperture that has a diameter slightly larger than the given diameter of the ball. Costello does not teach a ball

Appl. No. 10/686,125
Amdt. dated February 4, 2005
Reply to Office action of September 20, 2004

striking face on the device. Instead, Costello teaches a ball receiving aperture substantially larger than the given diameter of the ball. The opening of the Costello device is not circular, and the device would capture a ball whether the club is swung properly or not,. The device of Costello does not show a club striking face, but instead merely a circumferential rim. Thus, Costello does not provide the ability to demonstrate whether the ball striking face is returned to the appropriate orientation when the club is swung since the Costello device will capture the ball no matter the orientation of the face. Please, see Fig. 1 of Costello. Therefore, Costello does not anticipate the claims 1 and 17 and their dependent claims. No new matter has been added by the above underlined amended limitations. The limitations can be found as original in the present application on page 3, lines 9-10. Moreover, the limitations of claim 6 have been amended to claims 1 and 17. Thus, claim 6 is canceled. Withdrawal of the 35 U.S.C. 102(b) rejections is respectfully requested.

The Present Invention Is Not Obvious Over The Cited References

The Federal Circuit has ruled on numerous occasions that a holding of “obviousness” requires some motivation, suggestion or teaching within the cited references that would lead one skilled in the art to modify the cited reference or references as claimed by applicant. See, for example, *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed Cir. 2000):

"Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ

1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996)."

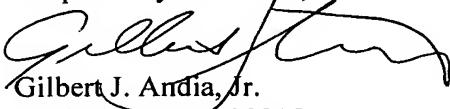
The cited and applied references including the present invention all disclose structures for the game of golf. However, the structures of the present invention as currently claimed are different than the structures of the cited references. None of these cited references suggest or teach alone or in combination a tapered ball-capturing cavity within the club head, the cavity opening to a circular ball-receiving aperture centered on the ball-striking face, wherein the ball receiving aperture has a diameter slightly larger than the given diameter of the ball. The tapered ball-capturing cavity of the present invention teaches proper golf swing because for the ball to be captured the club must be swung in a way to have the ball-striking face return to the ball in a position square to the direction of intended ball flight, and the ball must be centered upon the ball striking face. In contrast, the Costello golf club due to its large ball-capturing cavity and aperture relative to the ball will capture the ball even if it is struck non-squarely with a poor golf swing. Moreover, while the putter disclosed by Hull et al has a ball-capturing cavity, it is not tapered and would not be suitable to decelerate a driven ball. Modifying the Hull et al putter to have a tapered ball-capturing cavity would be contrary to its intended purpose of retrieving balls from hard to reach places. Furthermore, while the golf club head of Ezawa et al is hollow it does not have a tapered ball-capturing cavity for decelerating a driven golf ball, nor does Ezawa et al suggest alone or in combination with the other references a tapered ball-capturing cavity. None of the remaining cited references suggest or teach alone or in combination a tapered ball-capturing cavity

Appl. No. 10/686,125
Amdt. dated February 4, 2005
Reply to Office action of September 20, 2004

within the club head, the cavity opening to a circular ball-receiving aperture centered on the ball-striking face, wherein the ball receiving aperture has a diameter slightly larger than the given diameter of the ball.

In view of the foregoing amendment and for the above reasons, it is now believed that this application is now in condition for allowance. Accordingly, a Notice of Allowance is respectfully solicited. If unresolved issues remain, the Examiner is invited to telephone applicant's attorney at the number below.

Respectfully submitted,


Gilbert J. Andia, Jr.
Registration No. 38815
(336) 273-1600

Date: January 12, 2005
File No. 042730

CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the United States Postal Service as first-class mail in an envelope, addressed to Mailstop Amendment COMMISSIONER FOR PATENTS PO Box 1450 Alexandria VA 22313-1450 on February 14, 2005.

Gilbert J. Andia, Jr.
Name of Depositor


Signature

February 14, 2005 _____
Date of Signature _____